

REMARKS

Claims 1-3 are pending in the application. Claims 1-3 were rejected under 35 U.S.C. §112, second paragraph as described on page 2 of the Office Action. Claims 1-3 were rejected under 35 U.S.C. §103 as described on page 3 of the Office Action. Claim 1 is the only independent claim.

Applicants respectfully traversed the rejection of claims 1-3 under 35 U.S.C. §112, second paragraph for the following reasons.

M.P.E.P. §2172.01 indicates that a “claim which fails to interrelate essential elements of the invention as defined by Applicant(s) in the specification maybe rejected under 35 U.S.C. §112, second paragraph, for failure to point out and distinctly claim the invention.” Page 2 of the Office Action asserts that claim 1 fails “to define the location of a sensor device associated with the bearing device and the location of a control associated with the housing.”

It is respectfully submitted that claim 1 complies with 35 U.S.C. §112, second paragraph without specifically reciting the location of a sensor device or the control.

In particular, it is respectfully submitted that the sensor device is interrelated with the bearing device and that the control is interrelated with the housing. In particular, claim 1 clearly requires “a bearing device . . . including a sensor device.” Further, claim 1 requires a control “separated from said bearing device and functionally associated with said bearing device.”

As described in M.P.E.P. §2171, two separate requirements set forth in 35 U.S.C. §112, second paragraph are: (A) the claims must set forth the subject matter that the Applicants regard as an invention; and (B) the claims must particularly point out and distinctly define the needs and bounds of the subject matter that will be protected by the patent grant. As further described in M.P.E.P. §2173, the primary purpose of the second requirement of 35 U.S.C. §112, second paragraph is “to ensure that the scope of the claims is clear so that the public is informed of the boundaries of what constitutes infringement of the patent.” A second purpose is to “to provide a clear measure of what Applicants regard as the invention so that it can be determined whether the claimed invention meets all the criteria for patentability and whether the specification meets the criteria of 35 U.S.C. §112, first paragraph with respect to the claimed invention.” Still further, M.P.E.P. 2173.02 indicates the definiteness of claim language must be analyzed, not in a vacuum,

but in light of: (A) the content of the particular application disclosure; (B) the teachings of the prior art; (C) the claim interpretation that will be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.”

In light of the above discussion, it is respectfully submitted that one possessing the ordinary level of skill in the pertinent art at the time the invention was made would clearly understand the scope of claim 1, and would be informed of the boundaries of what constitutes infringement of claim 1. Specifically, a person having an ordinary skill in the art at the time the invention would understand that claim 1 is drawn to an electric discharge gas laser comprising, *inter alia*, housing, a rotating fan having a rotating shaft, a bearing device including a sensor device comprising a sensor and a signal processor, and a control. One of ordinary skill in the art at the time of the invention would further clearly understand that the bearing includes a sensor device.

In light of the above discussion, it is respectfully submitted that Applicants have sufficiently provided and interrelation between the elements of claim 1.

Page 2 of the Office Action further indicates that “it is not clear how the [2] control the bearing device on the basis of the processed signals.”

It is respectfully submitted that the question “how” is not addressed by 35 U.S.C. §112, second paragraph. Nevertheless, as discussed above with respect to M.P.E.P. §2173.02, it is respectfully submitted that the content of the disclosure of the present invention provides sufficient teaching for one of ordinary skill in the art to practice the invention. Further, it is respectfully submitted that one of ordinary skill in the art would understand how to control the bearing device based on the processed signal.

In light of the above discussion, it is respectfully requested that the rejection of claims 1-3 under 35 U.S.C. §112, second paragraph be withdrawn.

Applicants respectfully traverse the rejection of claims 1-3 under 35 U.S.C. §103, for the following reasons.

It is respectfully submitted that the ‘039 reference is assigned to Ebara Corporation. Furthermore, it is respectfully submitted that the present application is assigned to Ebara Corporation as indicated in the Assignment document recorded at Reel/Frame 011886/0209.

Effective November 29, 1999, 35 U.S.C. §103(c) provides that subject matter developed by another which qualifies as "prior art" under 35 U.S.C. §102(e) is not to be considered when determining whether an invention is sought to be patented is obvious under 35 U.S.C. §103, provided that subject matter in the claimed invention were commonly owned at the time the invention was made.

As indicated above it is respectfully submitted that the '039 reference and the present application were commonly owned by Ebara Corporation.

Accordingly, in light of 35 U.S.C. §103(c), it is respectfully submitted that the '039 reference is not to be considered when determining whether claim 1-3 are obvious under 35 U.S.C. §103.

In view of the above remarks, Applicants respectfully submit that claims 1-3 are patentable within the meaning of 35 U.S.C. §103, and urge that the rejection claims 1-3 under 35 U.S.C. §103 be withdrawn.

Having fully and completely responded to the Office Action, Applicants submit that all claims are now in condition for allowance, an indication of which it is respectfully solicited.

If there are any outstanding issues that might be resolved by an interview or Examiner's amendment, the Examiner is requested to call the Applicants at the telephone number shown below.

Respectfully submitted,

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